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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

PAN, YUWEN

ART UNIT

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2618

MAIL DATE

DELIVERY MODE

05/08/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/788,493	Applicant(s) SUONPERA ET AL.	
	Examiner YUWEN PAN	Art Unit 2618	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 February 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21,23-26,29-32,35-37,41-49 and 51-59 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21,23-26,29-32,35-37,41-49 and 51-59 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Response to Arguments

1. Applicant's arguments filed on 2/21/08 have been fully considered but they are not persuasive.

The applicant argues that prior art of record does not teaches the automatically selection of a second set of personalized information to be transmitted to the second portable device from the first set of personalized information based on the selected data category after the receiving of a first set of personalized information of a first memory of the first portable device from the first portable device upon initialized the data transfer. The examiner respectfully disagrees. Shanahan reference does teach a first portable device (Personal Computer 60, see figure 3) receives a first set of personalized information of a first memory (disc drive, column 5 and lines 29-41) for the preparation of data transferring. Then at the programmer, a second set of personalized information would be automatically selected base the selected data category (user defined information (see column 3 and lines 44-63). Furthermore, Shanahan reference teaches the modification of data files during transferring/downloading, if the data file is exceed the available memory size of device 20 (see column 6 and lines 43-54).

The applicants further request the support of the obvious rejection on the file format to be message box. Please see the office action for detail.

Based on foregoing reasoning, the previous rejection stands.

Claim Objections

2. Claim 59 is objected to because of the following informalities: a dependent claim can not be self-dependent. Appropriate correction is required.

DETAILED ACTION

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 21-26, 29-32, 35-37, 41-50, and 55-59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Piosenka et al (US005926756A) in view of Shanahan (US007149509B2) and Dahm et al (US006301471B1).

Per claim 21, Piosenka discloses a method comprising: prior to initializing a data transfer between a first portable device (see figure 1 and item 50, source) and a second portable device (see figure 1 and item 20), receiving a selection of a data category to be transferred to the second portable device (see column 3 and lines 33-36, wherein the user is able to choose certain information such as audio sample at the programmable device, also see column 2 and lines 1-4), initializing the data transfer (established the second communication link for data transmission based on the user selection); the programmable device is able to receive a first set of personalized information of a first memory of the first portable device from the first portable device from the first portable device upon initializing the data transfer (see column 3 and lines 44-63); automatically selecting a second set of personalized information to be transmitted to the second portable device from the first set of personalized information based on the selected data category (see column 3 and line 64-column 4 and lines 3, different blocks of information is transmitted).

Pisoenka doesn't expressly teach receiving data field information from the second portable device wherein the data field information includes size information of one or more data fields, modifying the second set of one or more personalized information in accordance with the data field information Shanahan teaches that device programmer (see figure 1, item 30, see column 6 and lines 43-54) would evaluate the data information (use-defined information) that is received from programmable device (item 20) and determine whether the potential transferable information is compatible with the programmable device (e.g. the device programmer would convert CD format to MP3 format, text files in which could be phonebook and messages, see column 3 and lines 33-63) it would have been obvious to one ordinary skill in the art at the time the invention was made to evaluate and modify according to the capability of the second portable device such that transmitted data would not exceed the capacity of the ending terminal.

Combination of Pisoenka and Shanahan does not teach that the text files for transferring are one of the phone book and the message box. Dahm teaches the modification of text content if the size of the text file exceeding the capacity of the receiving portable device (see figure 6). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the references to provide a better view for a user of the portable Device.

Same arguments apply, *mutatis mutandis*, to claim 29, 35, 41, and 55.

Per claim 23, Shanahan further teaches that each of the first connection and the second connection comprised a wire-based data connection.

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Per claim 24, Shanahan further teaches that the device programmer evaluate the second portable device's capabilities to receive the selected second set of personalized information (see column 3 and lines 44-53).

Same arguments apply, *mutatis mutandis*, to claim 30, 36.

Per claim 25, Picosenda further teaches that the first set of one or more personalized information is user selected (see column 6 and lines 39-47).

Same arguments apply, *mutatis mutandis*, to claim 31.

Per claim 26, Shanahan further teaches that each of the connection between the first and second portable device and computing device comprises a secure WAP session (see column 6 and lines 35).

Same arguments apply, *mutatis mutandis*, to claim 32, 37.

Per claim 42, Shanahan further teaches that the confirmation of the first data record is established (see column 6 and lines 35-41).

Per claim 43, Shanahan further teaches that the data storage specification include at least one of data filed size and a data type (see column 3 and lines 45-55).

Per claim 44, Shanahan further teaches that modifying the first data record in accordance with the storage specification including truncating at least a portion of the data first record (see column 3 and lines 44-64).

Per claim 45, Shanahan further teaches that writing command or send file command is executed after verification (see figure 10) and there is a chance that the file may already store in the programmable device (see column 11 and lines 21-32). It would have been obvious to one ordinary skill in the art to understand when a file is already stored in the storage the same file would be rejected at least would notify the user.

Per claim 56, Shanahan further teaches that an audio file would be converted/modified to or from PCM and WAV, etc (see column 3 and lines 44-63).

Per claim 57, Dahm further teaches that text file data would be modified to fit in the view of user screen (see figure 6).

Per claim 58 and 59, combination of Shanahan and Dahm does not teach of flagging one data record and halting transferring if the data record is empty. The examiner takes an "Office Notice" that it is notoriously well known in the art to notify a user that something he/she is looking for is not there. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have this feature to provide a better response system for the user of the portable device.

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5. Claim 51-54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Piosenka et al (US005926756A).

Per claim 51, Piosenka discloses an apparatus (see figure 1 and item 30) comprising: a processor (see figure 2 and item 34); and memory (see figure 2 and item 26) configured to store computer readable instructions that, when executed, cause the processor to perform a method comprising: prior to initializing a data transfer between a first portable device and a second portable device, receiving a selection of a data category to be transferred from the first portable device to the second portable device (see column 2 and line 1-5, column 3 and line 33-35); initializing the data transfer (see column 2 and line 1-12, second communication link); receiving a set of personalized information including a first data record from the first portable device upon initializing the data transfer; transmitting, to the second portable device, a request to write the first data record to the second portable device, wherein the first data record is selected for transmission to the second portable device based on the selected data category (see column 3 and lines 44-63); receiving, from the second portable device in response to the request, a confirmation including data field size information of one or more data fields included in a second data record of the second portable device, wherein the second data record (see column 6 and lines 43-55, the user has choices between cancel or modification if one the file is over the capacity of the reprogrammable device) corresponds to at least one of: a calendar, a phonebook, a message box and a call register; modifying the first data record in accordance with the data field size information (in a "scrolling" fashion, see column 6 and lines 50-54) then transmitting the modified data to the second portable device. Piosenka does not expressly teach that the second data record corresponds to at least one of: a calendar, a phonebook, a message

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box and a call register. But Piosenka does teach the reprogrammable device could a PDA, or a wireless device (see column 6 and lines 30-32). It would have been obvious to one of ordinary skill in the art at the time the invention was made to resize the data record of calendar and phonebook, etc. such that transmitted data would not exceed the capacity of the ending terminal.

Per claim 52, Piosenka further teaches that large data file is modified in a "scrolling" fashion so that all the requested information may be reviewed (see column 6 and lines 43-54).

Per claim 53, Piosenka further teaches that the data file is truncated in to sections (see column 6 and lines 43-54).

Per claim 54, Piosenka does not teach the feature of rejecting a data record as information already existed on the second portable device. The examiner takes an "Official Notice" that it is notoriously well known in the art for a portable device such as a computer to reject file or data that is already stored. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have this feature in order to reduce the redundancy and save memory space with limited capacity of a portable device.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to YUWEN PAN whose telephone number is (571)272-7855. The examiner can normally be reached on 8-5 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anderson D. Matthew can be reached on 571-272-4177. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Primary Examiner, Art Unit 2618
May 6, 2008